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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,607	02/19/2004	Mark V. Weckwerth	2502187-991300	1576

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EXAMINER

FARAH, AHMED M

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/783,607	Applicant(s) WECKWERTH ET AL.	
	Examiner Ahmed M. Farah	Art Unit 3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-88 is/are pending in the application.
 4a) Of the above claim(s) 16,48,51 and 79-88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15,17-20,23-39,42-47,49,50,52-57,60-69 and 72-78 is/are rejected.
- 7) ☒ Claim(s) 21, 22, 40, 41, 58, 59, 70, and 71 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>02/21/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claim 1-78, drawn to dermatological treatment apparatuses, classified in class 606, subclass 10.
- II. Claims 79-88, drawn to method of treating skin conditions, classified in class 606, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, a materially different apparatus can be used to provide dermatological treatments. Moreover, the apparatuses of invention I can be used to provide other and materially different treatments such as, tissue welding, treatment of scars, etc.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

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Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species: direct drive electrical circuit (claims 15 and 50) and a super-capacitor for energizing the light source (claims 16, 48 and 51). The claimed species are independent/distinct because the inventions as claimed do not overlap in scope.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 28 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation with the applicant's representative, Alan A. Limbach (Reg. NO. 39,749) on May 10, 2006, a provisional election was made

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without traverse to prosecute the invention of Invention I, claim 1-15, 17-47, 49-50 and 52-78. Affirmation of this election must be made by applicant in replying to this Office action. Claims 16, 51 and 79-88 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 28, 29, 31, 33, 35, and 44 are rejected under 35 U.S.C. 102(e) as being McDaniel by US Patent No. 6,663,659 B2.

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McDaniel discloses a handheld treatment apparatus for delivering optical energy to a biological tissue (see Fig. 35), the apparatus comprising:

a self-contained housing configured for gripping by a person's hand for cordless manipulation; a light source comprising one or more laser diodes within the housing; and a light path within the housing including an aperture through which output light pulses are propagated out of the housing (see Fig. 35 and col. 3, lines 36-62).

Furthermore, since the apparatus is a standalone light source comprising a power supply and a light-emitting device, it inherently has electrical circuit within the housing. With respect to claim 35, see example 6 of McDaniel

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 5-10, 12-15, 17, 18, 23, 28, 29, 31-37, and 42-44 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Smith US Patent No. 5,464,436.

Smith discloses a handheld tissue treatment apparatus comprising: at least one laser diode, a power supply within the handpiece, electrical circuit, and

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light path including an aperture in which the output light propagates out of the handpiece (see Figs. 1 and 3).

The apparatus of Smith weighs 125 gr (0.125 Kg) and has a diameter of approximately 2.1 cm and length of 20.3 cm. Hence, the volume of the apparatus, $V (\pi r^2 h)$, is about 70.3 cm^3 , which is much less than the volume (1500 cm^3) recited in the instant claims (see col. 3, lines 22-24).

With respect to claims 2, 10, and 12-14, the recited claims languages are directed to intended uses of the apparatus and, therefore, fail to add functional and/or structural limitations to claimed device. Furthermore, the apparatus of Smith could be used to provide the recited treatments.

With respect to claims 17, 18, 23, 36 and 37, the apparatus further comprises a contact sensor, which initiates lasing as a function of pressure. This sensor further provides an audible tone (see col. 3, lines 48-53). Although the pressure sensor of Smith is used when measuring the output power of the light source, the instant claims are broad enough to potentially infringe the sensor-handpiece combination of Smith.

With respect to claims 6, 7, 8, 32, 33, and 34, see Smith col. 3, lines 5-28; col. 4, lines 66-67; and col. 6, lines 37-38.

Smith does not teach the use long-pulse laser to provide the treatment. However, the relative use of long-pulse irradiation and continuous-wave (cw) irradiation is known in the medical art (see Fig. 6; col. 4, lines 61-63 of US Patent No. 4,733,660 to Itzkan). Hence, it is noted that one skilled in the art would have

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used a long-pulse laser as an alternative light source to the cw of Smith to provide the treatment.

6. Claims 1-15, 19, 20, 24-35, 38, 39, 43-47, 49-50, 52-57, 60-70, 73-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDaniel (US Pat. No. 6,663,659 B2) in view of Smith (US Pat. No. 5,464,436).

McDaniel, described above, discloses the recited limitations except the weigh and dimensions of the handpiece as claimed. With respect to claims 54, 55, 67, and 68, he further fails to teach the use of contact sensor. As to claims 19, 20, 38, 39, 56, 57, 69 and 70, the output window/lens of McDaniel would meet the recited limitations.

Smith, described above, discloses a medical handpiece having a weigh of less than one Kg and volume of less than 1500 cm^3 . As described above, the handpiece of Smith further comprises a contact sensor as claimed (see page 6, paragraph 3 of this Office Action).

Therefore, at the time of the applicant's invention, it would have been obvious to one skilled in the art to use a lightweight handpiece that can be easily grasped and held by human hand in order to comfort the user. It would have been further obvious to use a pressure sensor to trigger/activate the irradiation light in order to simplify the device such that the user can activate the device without manipulating additional switches.

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Allowable Subject Matter

7. Claims 21, 22, 40, 41, 58, 59, 70 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references:

US Patent No. Re. 36,634 to Ghaffari; US Patent No. 6,666,856 to Connors et al; US Patent No. 6,790,205 to Yamazaki et al; US Patent No. 6,264,649 to Whitcroft et al; US Patent No. 5,830,208 to Muller; US Patent No. 5,683,380 to Eckhouse; and US Patent No. 6,758,845 B1, respectively, disclose various skin treatment apparatuses comprising different types of skin contacting heat sinks.

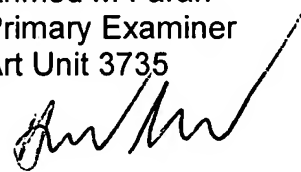
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M. Farah whose telephone number is (571) 272-4765. The examiner can normally be reached on Mon-Thur 9:30 AM-7:30 PM, and 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marmor II Charles can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ahmed M Farah
Primary Examiner
Art Unit 3735



May 11, 2006.